

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Victoria M. BELLOTTI et al.

Application No.: 09/683,532

Examiner: A. CHOUDHURY

Filed: January 16, 2002

Docket No.: 110143

For: SYSTEMS AND METHODS FOR INTEGRATING ELECTRONIC MAIL AND
DISTRIBUTED NETWORKS INTO A WORKFLOW SYSTEM

BRIEF ON APPEAL

Appeal from Group 2145

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I. REAL PARTY IN INTEREST

The real party in interest for this appeal and the present application is Xerox Corp., by way of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 012311, Frame 0191.

II. RELATED APPEALS AND INTERFERENCES

There are no prior or pending appeals, interferences or judicial proceedings, known to Appellants, Appellants' representative, or the Assignee, that may be related to, or that will directly affect or be directly affected by or have a bearing upon, the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-22 and 25 are on appeal.

Claims 1-22 and 25 are pending.

No claims are allowed, and no claims are objected to only for being dependent from a rejected base claim, but are otherwise allowable.

Claims 1-22 and 25 are rejected.

No claims are withdrawn from consideration.

Claims 23 and 24 are canceled.

IV. STATUS OF AMENDMENTS

No Amendment After Final Rejection has been filed in response to the November 19, 2007 Final Rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 is directed to a method for transmitting a workflow-enabled electronic mail message from a user of a workflow system to a recipient (*e.g.* Fig. 5, and paragraph 34), comprising creating an email message to the recipient by the user (*e.g.* element S110, Fig. 5, and paragraph 34), the recipient who does not have access to the workflow system (*e.g.* paragraph 33); determining a network address (*e.g.* element S120, Fig. 5, and paragraph 42); embedding a link to the determined network address in the email message to the recipient (*e.g.* element S130, Fig. 5, element 508, Fig. 11, and paragraph 44); associating a process of the workflow system with the determined network address (*e.g.* paragraph 44); and sending the email message having the link to the determined network address to the recipient (*e.g.* element S140, Fig. 5, and paragraph 42), wherein the link provides the recipient with an access to the associated process of the workflow system (*e.g.* element S270, Fig. 6, and paragraph 63).

Claim 3 is directed to the method according to claim 1, wherein determining the network address comprises generating the network address (*e.g.* element S120, Fig. 5, and paragraph 44).

Claim 4 is directed to the method according to claim 3, wherein generating the network address comprises randomly (*e.g.* paragraph 57), or pseudo-randomly (*e.g.* paragraph 60) generating the network address.

Claim 5 is directed to the method according to claim 3, wherein generating the network address comprises generating the network address based on at least in part on information about at least one of at least the created email message, the recipient, the workflow process and the user (*e.g.* paragraph 44 and 58).

Claim 8 is directed to the method according to claim 1, wherein determining a network address comprises determining a plurality of different network addresses (*e.g.*

paragraph 86); and embedding a link to the determined network address into the email message to the recipient comprises embedding a plurality of links into the email message (*e.g.* paragraph 87), each link being to one of the plurality of determined network addresses.

Claim 9 is directed to the method according to claim 8, wherein associating a process of the workflow system with the determined network address comprises associating a different state of the associated process of the workflow system with each of the plurality of determined network addresses (*e.g.* paragraph 86).

Claim 10 is directed to a method for transmitting a workflow-enabled electronic mail message from a user of a workflow system to a recipient (*e.g.* Fig. 7, and paragraph 33), comprising creating an email message to the recipient by the user (*e.g.* element S310, Fig. 7, and paragraph 34), the recipient who does not have access to the workflow system (*e.g.* element S405, Fig. 8, and paragraph 33); determining an email response address (*e.g.* element S320, Fig. 7, and paragraph 71); incorporating the determined email response address into the email message to the recipient (*e.g.* element 606, Fig. 12, and paragraph 72); associating a process of the workflow system with the determined email response address (*e.g.* paragraph 73); and sending the email message having the incorporated email response address to the recipient (*e.g.* element S340, Fig. 7, and paragraph 72), wherein the incorporated email response address provides the recipient with an access to the associated process of the workflow system (*e.g.* element S405, Fig. 8, and paragraph 73).

Claim 12 is directed to the method according to claim 10, wherein determining the email response address comprises generating the email response address (*e.g.* element S230, Fig. 7, and paragraph 80).

Claim 13 is directed to the method according to claim 12, wherein generating the email response address comprises randomly or pseudo-randomly generating the email response address (*e.g.* paragraph 71).

Claim 14 is directed to the method according to claim 12, wherein generating the email response address comprises generating the email response address based on at least in part on information about at least one of at least the created email message, the recipient, the workflow process and the user (*e.g.* paragraph 71).

Claim 19 is directed to the method according to claim 10, wherein determining an email response address comprises determining a plurality of different email response addresses (*e.g.* elements 710 and 712, Fig. 13, and paragraph 71); and incorporating the determined email response address into the email message to the recipient comprises incorporating the plurality of determined email response addresses into the email message (*e.g.* elements 710 and 712, Fig. 13, and paragraph 72).

Claim 20 is directed to the method according to claim 19, wherein associating a process of the workflow system with the determined email response address comprises associating a different state of the associated process of the workflow system with each of the plurality of determined email response addresses (*e.g.* elements 710 and 712, Fig. 13, and paragraph 72 and 73).

Claim 21 is directed to a method for accessing a workflow process using a workflow-enabled email message, comprising: receiving the workflow-enabled email message that includes a link to a network address associated with the workflow process (*e.g.* element S210, Fig. 6, and paragraph 77), wherein the network address is specific to the workflow process and to the email message (*e.g.* element S220, Fig. 6, and paragraph 77); selecting the link to access the network address, wherein, in response, the workflow system provides access to the workflow process (*e.g.* element S270, Fig. 6, and paragraph 79).

Claim 25 is directed to the method according to claim 3, wherein determining the network address further comprises excluding generated network addresses that have

previously been embedded in any previous e-mail messages created by the system that have not yet been accessed (*e.g.* paragraph 60).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

1) Claims 1-22 and 25 are rejected as having been obvious under 35 U.S.C. §103(a) over "Implementation of a Workflow-based Web Application with an Electronic Signature Mechanism," by Kim et al. (hereinafter "Kim") in view of U.S. Patent Application Publication No. 2002/0133495 to Rienhoff Jr. et al. (hereinafter "Rienhoff").

VII. ARGUMENT

The Office Action rejects claims 1-22 and 25 under 35 U.S.C. §103(a) as having been obvious over Kim in view of Rienhoff. However, with respect to the features recited in at least claims 1, 4, 5, 8-10, 13, 14, 19-21 and 25, the Office Action improperly applies the law relating to obviousness. Proper application of the law demonstrates that a *prima facie* case of obviousness has not been established, and that the claimed subject matter would not have been obvious over Kim in view of Rienhoff.

In this regard, the Office Action fails to consider the features of the relevant claims, as a whole, in maintaining the rejection. For example, claim 1 recites, among other features, creating an email message to a recipient by a user, the recipient who does not have access to the workflow system; embedding a link to a determined network address in the email message to the recipient; associating a process of the workflow system with the determined network address; and sending the email message having the link to the determined network address to the recipient, wherein the link provides the recipient with an access to the associated process of the workflow system. The combination of Kim and Rienhoff would not have reasonably suggested this combination of features, or those recited in the remaining claims, at least for the reasons discussed below.

A. The Combination Of Kim And Rienhoff Is Unreasonable

With regard to claims 1 and 10, the Office Action concedes that Kim does not disclose that the recipient of the email message does not have access to the workflow system prior to receipt of the e-mail message. The Office Action relies on Rienhoff to remedy the shortfall. The Office Action alleges that Rienhoff teaches how a user gains access to a secured area of a site after clicking on a link that can be received through an e-mail. The Office Action summarily concludes that it would have been obvious to one of ordinary skill in the art to

combine Rienhoff with Kim in order to "restrict access to secure content." These assertions are incorrect for at least the following reasons.

The conclusory statement that one of ordinary skill in the art would have combined the alleged teachings of Rienhoff with the Kim system in order to restrict access to secure content fails to recognize that Kim already restricts access to secure content. Thus, it would not have been obvious to one of ordinary skill in the art to have combined the alleged teachings of Rienhoff with Kim in the manner suggested.

The Examiner responds that, in the Examiner's opinion, Kim's design does not let users have access to the workflow system (secured areas) prior to the receipt of the e-mail embedded with a link. This response apparently concedes the premise of Appellants' argument that it would not have been obvious to one of ordinary skill in the art to have combined the alleged teachings of Rienhoff with Kim because Kim already "restricts access to secure content." Appellants maintain that a *prima facie* case of obviousness has not been established with respect to how any object lacking in Kim would be achieved with a reasonable expectation of success based on the alleged teachings of Rienhoff.

B. Rienhoff Does Not Teach Or Suggest The Relied Upon Features

Contrary to the assertion of the Office Action, Rienhoff does not teach, nor can it reasonably be considered to have suggested, the relied upon features. For example, the allegedly corresponding e-mail in Rienhoff may direct a user to a secure area of a website, but "access" to the secured area of the website is only gained by logging on with, for example, the log-in name and password established in step 750 (see paragraphs [0106] and [0113] of Rienhoff). Thus, the allegedly corresponding e-mail in Rienhoff does not provide a recipient who does not have access to the workflow system with an access to an associated process of the workflow system, as recited, for example in claim 1.

The Examiner responds that Rienhoff allegedly does not require a login when accessing the secured area. The Examiner asserts that a secondary login setup is available, but is optional in Rienhoff. The Office Action refers to paragraph [0112] of Rienhoff in support of this assertion. The Advisory Action, reiterates, in part, that Rienhoff allows access to a secured area of the site without a log in. However, the Examiner misinterprets the disclosure of Rienhoff with respect to these features.

Rienhoff requires one of two potential logins to gain access to the secured area of the site. Step 780 in Rienhoff, actually logging in to the secure area, with some login name and password, is not optional.

Rienhoff states that "in some embodiments, the user may be given, or requested to establish, an additional login name and/or password to permit them access to the secured area" (emphasis added). The Examiner interprets this to mean that access to a secured area of a site does not require a login as asserted, but is, rather, accessible via a link. However, paragraph [0113] clarifies that, in step 780, the user logs into the secured area of the website. The user may login with the login name and password established in step 750. Alternatively, if the user established a login name and password in step 776, the user may login with the log in name and password established in step 776. Thus, the language of paragraph [0112] clearly means that what is "optional" is whether an additional login name and/or password will be established. Step 780, actually logging in to the secure area, with some login name and password, is not optional. Rienhoff teaches that a user will login to establish access to the secured area of the website either by the login name and password established in step 750, or the login name and password established in step 776.

As such, the allegedly corresponding e-mail in Rienhoff does not provide a recipient who does not have to access to the workflow system with an access to an associated process of the workflow system, as recited, for example, in claim 1.

C. Kim Does Not Disclose The Subject Matter Recited In Claims 4, 5, 13 And 14

With regard to claims 4, 5, 13 and 14, the Office Action asserts that Kim teaches randomly or pseudo-randomly generating the network address. This assertion is incorrect. Kim does not address the relevant network addresses being generated. The Office Action apparently relies on a section in Kim that deals with generating an automatic random key code as teaching the generation of network address. However, the generating of the automatic random key code described in Kim does not correspond to generating a network address.

D. Kim And Official Notice Would Not Have Reasonably Suggested The Subject Matter Recited In Claims 8, 9, 19 and 20

Regarding claims 8, 9, 19 and 20, the Office Action concedes that Kim does not teach embedding multiple links within a single e-mail. The Office Action relies on Official Notice that is well known in the art that a plurality of links can be embedded in an e-mail for the purpose of sending multiple links without using multiple messages. However, such a modification of Kim would impermissibly alter Kim's method of operation and render it unsuitable for its intended purpose. Specifically, Kim teaches sending decision makers individual e-mails, specific to certain documents, with individual random keys. As such, careful control of the sequence of approval is achieved (see section 3.3 of Kim). Incorporating multiple links to various stages of the workflow process of Kim, with all of the corresponding random keys required by Kim, would defeat this purpose, rendering the invention of Kim unsuitable for its intended purpose.

The Office Action responds that "no alteration and methods of operation is required for embedding multiple links versus one link, within an e-mail." This analysis does not meaningfully address Appellants' argument that Kim's method of operation involves sending decision makers individual e-mails, specific to certain documents, with individual random

keys. Including multiple links within a single e-mail would clearly alter this method of operation. Additionally, the Examiner does not address the separate argument that such a modification would render Kim unsatisfactory for its intended purpose (see MPEP §2143.01 (V)). Appellants maintain that the asserted modification of Kim, to include multiple links within a single e-mail, would not have been obvious for at least these reasons.

E. Kim Does Not Disclose The Subject Matter Recited In Claim 21

Regarding claim 21, the Office Action asserts that Kim teaches the features recited in claim 21. The Office Action relies on page 2, right column, lines 9-22 and page 3, left column, first paragraph of Kim as teaching such features. This assertion is incorrect and does not address the relevant features of claim 21.

Claim 21 recites, among other features, selecting the link to access the network address, wherein, in response, the work flow system provides access to the work flow process. Kim does not teach or suggest at least this feature. According to Kim, on page 4, column 1, line 50-52, all users are authenticated by a unique e-mail address on the user management database. Thus, Kim provides that a user must be authenticated before being given access to the system.

F. Kim Does Not Disclose The Subject Matter Recited In Claim 25

Regarding claim 25, the Office Action asserts that Kim teaches excluding generating network addresses that have been embedded in previous e-mail messages created by the system that have not yet been accessed. The Office Action relies on page 2, second column, lines 25-40 of Kim as teaching such a feature. In the Response to Arguments section, the Office Action asserts that because Kim teaches that data within an e-mail, including the URL, can be encrypted to prevent it from being exposed, this means that the URL within each e-mail is "unique." This assertion is incorrect and does not address the relevant features of claim 25.

For example, the fact that information may be encrypted for transmission, and decrypted for use, does not mean that URLs within each e-mail are unique. For example, if the same URL were sent to several users via encryption, even though each message might contain different encrypted data, the URL may be the same.

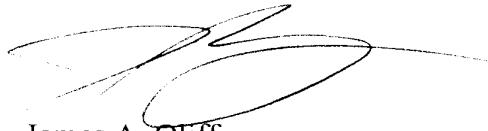
Moreover, this does not correspond to excluding generated network addresses that have previously been embedded in any previous e-mail messages created by the system that have not yet been accessed. The feature of claim 25 allows for network addresses that have been accessed to be used again. There is no teaching or suggestion in the applied references of excluding generated network addresses that have previously been embedded in any previous e-mail messages created by the system that have not yet been accessed.

The Examiner maintains, in the Response to Arguments section, that the URL within each e-mail being unique is considered to correspond to excluding generated network addresses that have previously been embedded in any previous e-mail messages created by the system that have not yet been accessed. Kim does not teach excluding and does not allow for the reuse of network addresses that have been accessed. Any statistical "uniqueness" achieved by Kim does not reasonably correspond to specifically excluding any previously generated network addresses, much less those that have previously been embedded in any previous e-mail messages created by the system that have not yet been accessed. Likewise, merely encrypting a URL within an e-mail does not correspond to excluding generated network addresses.

VIII. CONCLUSION

For all of the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 1-22 and 25 are in condition for allowance. For all of the above reasons, Appellants respectfully request this Honorable Board to reverse the rejections of claims 1-22 and 25.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'James A. Oliff', with a large, stylized loop at the end.

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Filed: July 18, 2008

APPENDIX A - CLAIMS APPENDIX

CLAIMS INVOLVED IN THE APPEAL:

1. A method for transmitting a workflow-enabled electronic mail message from a user of a workflow system to a recipient, comprising:
 - creating an email message to the recipient by the user, the recipient who does not have access to the workflow system;
 - determining a network address;
 - embedding a link to the determined network address in the email message to the recipient;
 - associating a process of the workflow system with the determined network address; and
 - sending the email message having the link to the determined network address to the recipient, wherein the link provides the recipient with an access to the associated process of the workflow system.
2. The method of claim 1, wherein determining the network address comprises selecting the network address from a list of predefined network addresses.
3. The method of claim 1, wherein determining the network address comprises generating the network address.
4. The method of claim 3, wherein generating the network address comprises randomly or pseudo-randomly generating the network address.
5. The method of claim 3, wherein generating the network address comprises generating the network address based on at least in part on information about at least one of at least the created email message, the recipient, the workflow process and the user.
6. The method of claim 1, further comprising associating the determined network address with the email message.

7. The method of claim 6, wherein associating the determined network address with the email message comprises associating an email address of the recipient to which the created email will be sent with the determined network address.

8. The method of claim 1, wherein:
determining a network address comprises determining a plurality of different network addresses; and
embedding a link to the determined network address into the email message to the recipient comprises embedding a plurality of links into the email message, each link being to one of the plurality of determined network addresses.

9. The method of claim 8, wherein associating a process of the workflow system with the determined network address comprises associating a different state of the associated process of the workflow system with each of the plurality of determined network addresses.

10. A method for transmitting a workflow-enabled electronic mail message from a user of a workflow system to a recipient, comprising:

creating an email message to the recipient by the user, the recipient who does not have access to the workflow system;

determining an email response address;

incorporating the determined email response address into the email message to the recipient;

associating a process of the workflow system with the determined email response address; and

sending the email message having the incorporated email response address to the recipient, wherein the incorporated email response address provides the recipient with an access to the associated process of the workflow system.

11. The method of claim 10, wherein determining the email response address comprises selecting the email response address from a list of predefined email response addresses.

12. The method of claim 10, wherein determining the email response address comprises generating the email response address.

13. The method of claim 12, wherein generating the email response address comprises randomly or pseudo-randomly generating the email response address.

14. The method of claim 12, wherein generating the email response address comprises generating the email response address based on at least in part on information about at least one of at least the created email message, the recipient, the workflow process and the user.

15. The method of claim 10, further comprising associating the determined email response address with the email message.

16. The method of claim 15, wherein associating the determined email response address with the email message comprises associating an email address of the recipient to which the created email will be sent with the determined email response address.

17. The method of claim 10, wherein incorporating the determined email response address into the email message to the recipient comprises incorporating the determined email response address into a reply-to portion of the email message.

18. The method of claim 10, wherein incorporating the determined email response address into the email message to the recipient comprises incorporating the determined email response address into a selectable element of the email message.

19. The method of claim 10, wherein:
determining an email response address comprises determining a plurality of different email response addresses; and

incorporating the determined email response address into the email message to the recipient comprises incorporating the plurality of determined email response addresses into the email message.

20. The method of claim 19, wherein associating a process of the workflow system with the determined email response address comprises associating a different state of the associated process of the workflow system with each of the plurality of determined email response addresses.

21. A method for accessing a workflow process using a workflow-enabled email message, comprising:

receiving the workflow-enabled email message that includes a link to a network address associated with the workflow process, wherein the network address is specific to the workflow process and to the email message;

selecting the link to access the network address, wherein, in response, the workflow system provides access to the workflow process.

22. The method of claim 21, further comprising:

receiving a request to provide authentication from the workflow system in response to selecting the link; and

providing the requested authentication to the workflow system, the workflow system denying access to the workflow process if the requested authentication is not valid.

25. The method of claim 3, wherein determining the network address further comprises:

excluding generated network addresses that have previously been embedded in any previous e-mail messages created by the system that have not yet been accessed.

APPENDIX B - EVIDENCE APPENDIX

NONE

APPENDIX C - RELATED PROCEEDINGS APPENDIX

NONE